

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Venegas, Jr.

Serial No.: 09/815,628

Group No.: 3679

Filed: March 23, 2001

Examiner: V. Macarthur

For: HANDRAIL SYSTEM

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Restriction Requirement mailed June 10, 2002, Applicant hereby elects Species 2, with traverse, directed to the embodiment shown in Figures 5-8. This elected embodiment includes claims 5-21 of the present application. Applicant believes species 2, 3 and 4 should be combined, as they all have in common an infill panel, regardless of their construction.

Respectfully submitted,

By: 

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Date: June 20, 2002

Office Action Summary

Application No.

09/815,628

Applicant(s)

VENEGAS, FRANK

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213...

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 11-14, 16 and 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

The disclosure is objected to because of the section headings appear in lowercase and are underlined. As provided in 37 CFR 1.77(b), the specification of a utility application should include section headings appearing in upper case, without underlining or bold type.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5396739 to Venegas.

Regarding claims 9 and 10, Venegas (USPN 5396739) discloses (figs.1-3) a handrail assembly comprising a perimeter frame (12, 16, 22, 26) composed of upper and lower and vertical rails. The lower portions of the vertical rails are configured to engage a support surface (48). The rails are composed of steel tubing, covered with plastic sheathing (14, 18, 24, 28). The perimeter frame surrounds a framed area (30). An infill panel (40) is disposed in the framed area such that the panel is surrounded by the perimeter frame (col.2, ll.61-66).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5396739 to Venegas in view of Clemmons (USPN 4053140).

As to claim 15 and 17, Venegas (USPN 5396739) does not explicitly disclose structural fittings interconnecting the rails with the posts such that they are releasably engaged. Clemens teaches slip-on structural fittings (18h) interconnecting rails (20) with posts (44). The inner diameter of the fitting is greater than the outer diameters of the post and rail. It has generally been recognized that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made modify the fitting of Clemmens to fit over and connect the rails, posts and sheathing of Venegas (USPN 5396739) so that the rails are releasably engaged with the posts (Clemens, col.1, ll.50-55).

Response to Arguments

Applicant's election with traverse of species 2 and claims 5-21 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that "species 2, 3 and 4 should be combined as they all have in common an infill panel, regardless of their construction." This is not found persuasive since the fact that multiple species have one or more limitations in common is not, in and of itself, sufficient evidence that the species are obvious variants of each other. Species are necessarily closely related, however this fact is irrelevant to the question of whether or not restriction is proper. What is relevant is whether or not the species are patentably distinct. See MPEP § 808.016. For instance, the slip-on fitting (40) of species 2 (figs.5-8) is not shown in species 4 (figs.14-22) nor is the slip-in fitting (290) of species 4 shown in species 2. The u-

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shaped channels (104, 112) of species 2 are not shown in species 3 (figs.9-13) nor are the clips (222) of species 3 shown in species 2. The slip-on fittings (210) of species 3 are not shown in species 4 nor are the slip-in fittings (290) of species 4 shown in species 3. The applicant has failed to provide evidence that the species are obvious variants or to admit on the record that this is the case. Accordingly, the requirement is still deemed proper and is therefore made FINAL.

Claims 1-4 and 22-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Claims 5-8, 11-14, 16 and 18-21 are withdrawn from consideration, as they do not read on elected species 2 shown in figs.5-8.

Regarding claims 5-8, the limitation "each fitting having a securing mechanism engaging the rails or the posts without penetrating the polymerized sheathing", in lines 11 and 12 of claim 1 renders claim 1 unreadable on species 2 (figs.5-8) since the fitting (40) is described in the specification (p.8, ll.10-20) as being secured by set screw (42) which penetrates the polymerized sheathing (best seen in fig.3 of species 1). Claims 5-8 depend from claim 1 and contain all of the limitations of claim one. Therefore, claims 5-8 do not read on species 2. Note that although species 1 and species 2 have fitting (40) in common, species 2 does not contain cross-fitting (70) and species 1 does not show panel (106).

As to claims 11-14, the limitation "at least one of the structural fittings comprising a slip-in fitting" in lines 2 and 3 of claim 11 appears to be drawn to species 4 (figs.14-22) and is not

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supported by species 2 (figs.5-8) since all of the fittings of species 2 are slip-on fittings.

Therefore, claim 11 does not read on species 2. Claims 12-14 depend from claim 11 and contain all of the limitations of claim one. Therefore, claims 12-14 do not read on species 2.

As to claim 16, the limitation "a set screw operable to press against the plastic sheathing such that the fitting grips the sheathing and the post or rail without penetrating the sheathing" in lines 2-3 of claim 16 appears to be drawn to species 3 (figs. 9-13) and is not supported by species 2 (figs. 5-8) since the fitting (40) is described in the specification as being secured by set screw (42) which penetrates the polymerized sheathing (best seen in fig.3 of species 1). Therefore, claim 16 does not read on species 2.

As to claims 18-21, the limitation "at least one of the structural fittings comprising a slip-in fitting . . . further having an engagement member . . . configured to engage the inner diameter of the posts or rails" in lines 2-6 of claim 18 appears to be drawn to species 4 (figs. 14-22) and is not supported by species 2 (figs. 5-8) since all of the fittings of species 2 are slip-on fittings, none of which contain engagement members engaging the inner diameters of posts or rails. Therefore, claim 18 does not read on species 2. Claims 19-21 depend from claim 18 and contain all of the limitations of claim 18. Therefore, claims 19-21 do not read on species 2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (703) 305-5701. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (703) 308-1159. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

VLM
July 26, 2002

Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3600